

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/614,105 Confirmation No. 7653  
Applicant : A. YAMAZAKI et al. TC/GAU : 1797  
Filed : July 8, 2003 Examiner : Neil N. Turk  
Title : AUTOMATIC ANALYZER  
Docket No. : KAS-187  
Customer No.: 24956

**REPLY BRIEF**

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January 24, 2011

This Reply Brief is being filed in response to the Examiner's Answer mailed on November 23, 2010. In response to Section (10) Response to Argument at pages 7-9 of the Examiner's Answer, Applicants respectfully submit the following.

**I. The Examiner's Motivation for Modifying Ohishi and Ginsberg in view of Itoh is Fatally Flawed**

[01] At page 9, lines 1-5 of the Examiner's Answer, the Examiner states: "Examiner argues that Itoh has not been provided as a modifying reference for particular disclosure to structural elements not specifically disclosed within the primary reference of Ohishi. Examiner argues that Itoh has been provided for a teaching of applying a control operation in which the dispensing probes are operated in an alternating manner so as to yield faster processing times and thereby higher throughput." At page 9, lines 18-21 of the Examiner's Answer, the Examiner states: "Examiner argues that the combination of the one-to-one system of Ohishi with the

two-to-one system of Ginsberg provides an obvious combination that yields increased throughput by providing a second, clean, dispensing probe that is available for immediate use on the next progression.” However, the Examiner fails to explain how controlling dispensing in an alternating manner in the system of Ohishi or Ginsberg would yield increased throughput.

[03] In Itoh, the location for taking up sample is the same for both mechanisms 30A and 30B (stopper 62), and the location for distributing sample is the same for both mechanisms 30A and 30B (stopper 64). As such, the structure physically requires that the taking up operation and the distributing operation be alternately performed by the two mechanisms 30A and 30B. Neither Ohishi nor Ginsberg show a system in which the location for taking up sample is the same for both dispensing mechanisms or the location for distributing sample is the same for both dispensing mechanisms. As such, there is no need to control dispensing in an alternating manner in order to provide “a second, clean, dispensing probe that is available for immediate use on the next progression.” There is no evidence that dispensing in an alternating manner in the Ohishi/Ginsberg system would “yield faster processing times and thereby higher throughput.”<sup>1</sup> Therefore, the Examiner’s motivation to modify Ohishi/Ginsberg in view of Itoh is fatally flawed.

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<sup>1</sup> Applicants note that the Examiner explicitly argues at page 9, lines 1–5 that “Itoh has not been provided as a modifying reference for particular disclosure to structural elements not specifically disclosed within the primary reference of Ohishi.” Thus, there is no motivation to modify Ohishi/Ginsberg so as provide the same taking up location and/or the same distributing location for both dispensing mechanisms.

## **II. The Combination of Ohishi, Ginsberg, and Itoh is the Result of Hindsight Reconstruction**

[04] At page 11, lines 7-19 of the Examiner's Answer, the Examiner states: "Examiner argues that the disclosures of Ohishi, Ginsberg, and Itoh have not been utilized to read over the claims by way of a hindsight analysis. As discussed above in the body of the action, articulated reasoning has been supplied for the motivation to combine Ginsberg and Itoh with the primary reference of Ohishi. Examiner asserts that the combination of Ohishi, Ginsberg, and Itoh provide an obvious combination to one of ordinary skill in the art. Examiner additionally notes that an incompatibility in the structure of the references does not exist, as purported by Appellant. Specifically with respect to Itoh, Examiner reasserts that Itoh was provided for disclosure to a particular control operation undergone by pairs or dispensing mechanisms and was not supplied for particular structural elements. Examiner asserts that the combination of Ohishi and Ginsberg provide to disclosure all of the structural elements of the claim, and Itoh provides disclosure to the control operation applied to the dispensing operation."

[05] The Examiner fails to address the issue raised in the Appeal Brief at page 11, lines 2-6: "In the second scenario, the two reagent disks are not required to provide a single take up location for either the first reagent or the second reagent but, in that case, there is no motivation to control the dispensing of the first reagent by two mechanisms in an alternating manner and no motivation to control the dispensing of the second reagent by two mechanisms in an alternating manner." As discussed

above, there is no evidence that controlling dispensing in an alternating manner in the Ohishi/Ginsberg system would “yield faster processing times and thereby higher throughput.” Therefore, the Examiner’s motivation to modify Ohishi/Ginsberg in view of Itoh is fatally flawed. As such, a person of ordinary skill in the art, without the benefit of hindsight and using independent claim 13 or 19 as the blueprint for piecing together the prior art (including “alternating manner”) to defeat patentability—the essence of hindsight, would not have the motivation to combine Ohishi/Ginsberg and Itoh in the manner suggested by the Examiner.

## CONCLUSION

To the extent necessary, applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1417 (KAS-187) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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